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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,191	11/21/2001	Stephen J. Padden	HM-69621	4104

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KENNETH J. HOVET
NORDMAN, CORMANY, HAIR & COMPTON
P.O. BOX 9100
1000 TOWN CENTER DRIVE
OXNARD, CA 93031-9100

EXAMINER

TRUONG, THANH K

ART UNIT PAPER NUMBER

3721

DATE MAILED: 12/15/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,191

Applicant(s)

PADDEN, STEPHEN J.

Examiner

Thanh K Truong

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed. :
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/1/01
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, drawn to a tool that including a stapler, classified in class 227, subclass 76.
 - II. Claims 12 and 13, drawn to a method of using a multi-purpose tool, classified in class 173, subclass 1.
 - III. Claims 14-20, drawn to drawn to a tool that including a punch, classified in class 30, subclass 414.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a stapler that is detachable from the housing. See MPEP § 806.05(d).

Inventions II and (I & III) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as any multiple functional tool holder that houses variety of tools that are detachable from the housing.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Mr. Kenneth Hovet on September 24, 2004, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Chiou (4,807,744) or Tsuji (4,753,346).

Chiou discloses an apparatus comprising:

a housing 1;

a stapler 21 is detachably mounted to the housing, the stapler having an actuating member; and

a recess 11 in the housing that is engageable with the actuating member when the stapler is mounted to the housing.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiou (4,807,744) or Tsuji (4,753,346) in view of Padden (6,009,584).

As discussed above in paragraph 5 of this office action, Chiou discloses the claimed invention, but does not expressly disclose the recess for the stapler as recited in claims 2-8, however, it is well known in the art to create recess in the housing of the multiple-purpose tool holder in such a way that the recess accommodates the shape and size of the tool being inset to the housing. The recess comprises slot, curve portion, flange, tab, etc.

Chiou shows recesses in the housing to accommodate the shape of varieties of tool, such as recess 11 for the stapler, recess 15 for the pen 5, recess 12 for the knife 3, etc.

Pedden's disclosure further support the contention that it is well known in the art to create recess in the housing of the multiple purpose tool holder with varieties of shapes and sizes to accommodate varieties of tool. Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Chiou by incorporating the creation of recesses in the housing of the multiple-purpose tool holder to fit different tools as taught by Peddent.

As for a hole punch to fit an opening at the corner opening in the tool housing as recited in the claim 9, the examiner take official notice that it is within the skill of one in the art to provide a hole puncher in the multiple purpose tool holder providing a complete stationery tool set.

8. Claims 2-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiou (4,807,744) or Tsuji (4,753,346) in view of Ng (6,145,994).

As discussed above in paragraph 5 of this office action, Chiou discloses the claimed invention, but does not expressly disclose a lighting means mounted within the housing and oriented for illumination through the aperture, and an activation means to illuminate the lighting.

Ng discloses an apparatus comprising lighting means 30 mounted within the aperture and an activation means 28 to illuminate the lighting, Ng apparatus provides the multiple-purpose tool holder with lighting capability. Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Chiou by incorporating the lighting apparatus as taught by Ng providing the multiple-purpose tool holder with lighting capability.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K Truong whose telephone number is (571) 272-4472. The examiner can normally be reached on Mon-Thurs from 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tkt

December 8, 2004.



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700